

REMARKS

Claims 1-20 are pending in the present Application. Claim 6 has been canceled and Claims 1, 11, 16, and 18 have been amended, leaving Claims 1-5 and 7-20 for consideration upon entry of this amendment. Support for the amendments to the claims is discussed below.

The specification has been amended as discussed below. No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Drawings

Submitted herewith are drawing sheets correctly labeled as replacement sheets. No changes have been made to the drawing.

Objections to the Specification

Applicants wish to thank the Examiner for the detailed reading of the specification. Applicants have amended to specification to address the Examiner's concerns.

Claim Objections and Amendments

Applicants have amended the claims to address the Examiner's objections to the claims. In particular, Claims 1, 16, and 18 have been amended to remove the word "viscosity" from the phrase "second viscosity poly(arylene ether) resin" which was the result of a typographical error. Claim 11 has been amended to include the units for melt viscosity. Claim 1 has been amended to include the limitations of Claim 6. Claim 16 has been amended to include the limitations of Claim 6 and Claim 3. Claim 18 has been amended to include the limitations of Claim 11 and Claim 3.

Claim Rejections over U.S. Patent No. 6,576,700

Claims 1-12 and 14-19 stand rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,576,700 to Patel (Patel). Applicants respectfully traverse this rejection.

Patel discloses a genus of polyphenylene resin compositions with improved HDT

values and flame retardance comprising a blend of at least two polyphenylene ether resins. The first resin (Component A) has an intrinsic viscosity of at least 0.3 dl/g and the second resin (Component B) has an intrinsic viscosity of less than 0.25 dl/g. (Abstract) In addition to the two polyphenylene ether resins, Patel discloses a wide range of potential additional components such as vinyl aromatic resins (which serve as plasticizers), impact modifiers, flame retardants, plasticizers, antioxidants, fillers, conductive fillers, reinforcing agents, stabilizers, lubricants, colorants, dyes, pigments, drip retardants, and flow modifiers. (Paragraphs [0043] to [0048]) These teachings, taken together, indicate that the genus disclosed by Patel is large and diverse.

Additionally, Patel focuses on the flame retardant properties of the composition. In fact, Patel indicates a preference for flame retardants that are free of halogens such as organophosphates. (Paragraph [0057]) All examples of Patel include the presence of bisphenol-A disphosphate (BPA-DP). In fact, the Examiner has cited the Examples as evidence that the compositions of Patel meet the melt viscosity limitations of the dependent claims. Applicants respectfully assert that the plasticizing effect of organophosphates is well known. (see for example U.S. Patent No. 4,224,209, Col. 3, lines 11-17) Additionally, Examples 24-39 of the pending application specifically demonstrate the rather dramatic plasticizing effect of BPA-DP.

The effect of the disclosure of a genus on the patentability of a species depends on the size of the genus and the disclosure of preferred sub-genera and/or species, if any. With a genus of sufficiently limited and defined substituents, one may find anticipation. *Ex parte A*, 17 U.S.P.Q.2d, 1716, 1718 (Bd. Pat. App. & Int. 1990). In other words, a genus will anticipate a species within that genus but not expressly disclosed, if one of ordinary skill in the art “would immediately envisage” the claimed compound or composition from the disclosed genus. *In re Petering*, 301 F.2d 676, 682, 133 U.S.P.Q. 275, 280 (C.C.P.A. 1962).

Applicants respectfully assert that Patel discloses a broad genus of compositions and one of ordinary skill in the art, given the totality of Patel’s disclosure, would not “immediately envisage” the instantly claimed compositions, particularly since the claimed compositions are required to have a specified melt viscosity in the absence of plasticizer.

Additionally, Applicants note that in order to anticipate, a piece of prior art must clearly and unequivocally disclose the claimed composition or direct those skilled in the art to the composition without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *In re Arkley*, 59 CCPA 804, 455 F.2d 586, *Air Products & Chemicals, Inc. v. Chas. S. Tanner Co.* 219 USPQ 223, *Perricone v. Medicis Pharmaceutical Corp*, 267 F.Supp.2d 229. Applicants respectfully assert that Patel does not clearly and unequivocally disclose the instantly claimed compositions and further more does not direct one of skill in that art to a composition with a melt viscosity less than or equal to 190 Pascal-seconds at 1500 seconds⁻¹ and a temperature of 320°C in the absence of filler or to a composition with a melt viscosity less than or equal to 270 Pascal-seconds at 1500 seconds⁻¹ and a temperature of 320°C in the presence of filler. Patel does not teach how to achieve such low melt viscosities in the absences of a plasticizer.

For at least the reasons given above Applicants respectfully assert that the pending claims are not anticipated by Patel.

Claims 1-12 and 14-19 stand rejected under the judicially created doctrine of obviousness type double patenting in view of Patel. While Applicants respectfully assert that Patel does not provide sufficient information to make obvious the claimed composition, Applicants have elected to submit a Terminal Disclaimer in order to advance prosecution. A Terminal Disclaimer is submitted herewith.

Claims 1-12 and 14-19 stand rejected under 35 U.S.C. §103(a) as being obvious over Patel. While Applicants respectfully assert that Patel does not provide sufficient information to make obvious the claimed composition, Applicants have elected to submit a Statement of Common Ownership in order to advance prosecution. A Statement of Common Ownership is submitted herewith.

Claims 13 and 20 are rejected under 35 U.S.C. §103(a) as being obvious over Patel in combination with U.S. Patent No. 5,218,030 to Katayose. Applicants respectfully assert that in light of the Statement of Common Ownership the rejection is moot.

Claim Rejections over U.S. Patent Application No. 10/604,214

Claims 1-3, 7, 8, 10 and 15 are provisionally rejected under the judicially created doctrine of obviousness type double patenting in view of co-pending Application No. 10/604,214. Applicants respectfully assert that in light of the amendment of independent Claim 1 to include the limitations of Claim 6 this rejection is overcome. In addition, Applicants wish to point out that the pending claims are directed to thermoplastic compositions, which are essentially different from curable compositions and thermoset compositions. Application No. 10/604,214 is directed to curable compositions.

Claim Rejections over U.S. Patent No. 5,258,455

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,258,455 to Laughner et al. (Laughner). Applicants respectfully traverse this rejection.

As mentioned above Claim 1 has been amended to include the limitations of Claim 6. As Claim 6 was not rejected in view of Laughner, Applicants believe that this rejection should be withdrawn in view of the amendments. Additionally, Applicants note that Laughner is directed to a curable composition which is fundamentally different from the instantly claimed thermoplastic composition.

Claim Rejections over U.S. Patent Publication No. 2001/0053820

Claims 1, 2, 7, 8-10, 14, and 15 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent Publication No. 2001/0053820 to Yeager et al. (Yeager). Applicants respectfully traverse this rejection.

As mentioned above Claim 1 has been amended to include the limitations of Claim 6. As Claim 6 was not rejected in view of Yeager, Applicants believe that this rejection should be withdrawn in view of the amendments. Additionally, Applicants note that Yeager is directed to a thermosetting composition, which is fundamentally different from the instantly claimed thermoplastic composition.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-1131.

Respectfully submitted,

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